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09/774,492	01/31/2001	Daniel J. Graney	P/12-839	3104

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/774,492

Applicant(s)

GRANEY, DANIEL J.

Examiner

Tamra L. Dicus

Art Unit

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-- Th MAILING DATE of this communication app ars on the cover sh et with th correspond nce address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Response to Amendment*

This Office Action is responsive to the amendment filed 7-3-03. Cancellation of claims 10-22 are acknowledged.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No.

5,451,449 to Shetty et al. in view of USPN 6,459,514 to Gilbert et al.

3. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Claims 1-9 directed to an invention not patentably distinct from claims 1-9 of commonly assigned U.S. Patent No. 5,451,449 to Shetty et al.

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,451,449 to Shetty et al. in view of USPN 6,459,514 to Gilbert et al.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims an uniaxial oriented multilayered film, while the Shetty reference claims a film that has not been oriented uniaxially having a mechanical property ultimate tensile at break of 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2), thickness of 0.007-0.034 mm, and thread width of 0.15 to 0.33 mm (claim 9). However, it would have been obvious to one of ordinary skill in the art to make an uniaxial oriented multilayered film having a mechanical property ultimate tensile at break of 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2) since Gilbert teaches it is known to uniaxially stretch/orient a coextruded multilayered iridescent film. A multilayered iridescent film having tensile at break being 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2) is optimizable. Especially since the film has the same thickness as Applicant claims. The same film thickness is *claimed* in Shetty. Stretching the film of Shetty to yield the tensile at break property as in the instant application is optimizable because tensile at break is effected by

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the stretch ratio and thickness of a film. It is a common property obtained from a mechanical test using an instrument such as an Instron. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

Furthermore, stretching films are varied to produce the desired refractive index as taught by Gilbert at col. 5, lines 10-20 and col. 7, lines 1-3. Hence it would have been obvious to one of ordinary skill in the art to modify the film of Shetty where a multilayered iridescent film has a tensile at break of 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2) since it has been held that experimental modification of the prior art in order to ascertain optimum operating conditions (e.g. stretch ratios, temperatures, speed of the tensile gauges, or other process variables that effect mechanical properties such as tensile strength/tear) fails to render Applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233.

Regarding claims 3 and 6, Shetty teaches the refractive index is at least about 0.06. See patented claim 6. Also regarding the amount of multilayers being at least 35 in instant claims 3 and 6, see patented claim 4.

Regarding claims 4 and 7, the film being a terephthalate is claimed, see patented claim 7.

Regarding claim 5 and 8, the only difference is that the contiguous adjacent layer is a thermoplastic elastomer. An elastomer is well known in the art to use since Gilbert teaches elastomers are suitable to use in coextruded films in the skin layers at col. 5, line 61. Gilbert teaches polybutadiene as a specific suitable resin. Hence it would have been obvious to one of ordinary skill in the art to modify the uniaxial oriented film of Shetty to include an elastomer since Gilbert teaches elastomers can be used to protect the inner/base layers at col. 11, lines 20-50.

Regarding claim 9, Patent '499 differs in that it is not formed in a microfilament having a width of 0.15 to 3 mm. However, Shetty provides the same film. That the film is formed in a thread having the aforesaid width is not in itself construed to be a matter of invention. It is well known to change the shape and size of a film which happens to be the same material commensurate with the use. For example, plastic tape, food wrap, or lenses have various thicknesses. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Further, a film formed as a thread having a 0.15 to 3 mm width is a mere optimizable adjustment as width is a result effective property. Width effects the strength. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

### ***Response to Arguments***

1. Applicant's arguments filed 7-3-03 have been fully considered but they are not persuasive.
2. The Applicant believes that since Gilbert does not mention a tensile strength value that it is not obvious to teach. The Applicant has not persuasively argued. As previously stated, mechanical test properties such as tensile at strength values are optimizable and are result effective variables. A tensile at strength value is naturally present when the same thickness and materials are provided. The same film thickness is claimed in Shetty. Gilbert teaches it is known to stretch films uniaxially, as the instant invention claims. The same materials, thickness, and processes are provided by the prior art and one skilled in the art would be inclined to

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produce an obvious variation of the film claimed by Shetty. The Applicant has not provided any objective evidence to prove otherwise.

3. Applicant alleges the reason for stretching the film of Gilbert is not present in either Shetty or the instant invention. The reason of Gilbert does not have to be present in Shetty. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) (discussed below). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references “without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done” (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

4. In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As stated above, the same material and thickness is claimed. Tensile at break values are obtained from stretching the films on an Instron-type tester. It is obvious to obtain the instantly claimed values.

Applicant further states while it is obvious to optimize a property, a reason to optimize a property must be relied upon. The Applicant has not persuasively argued. The Examiner has previously given reasons to optimize tensile at break. The film has the same materials and the same thickness as Applicant claims. The same film thickness is *claimed* in Shetty. Stretching the film of Shetty to yield the tensile at break property as in the instant application is optimizable because tensile at break is effected by the stretch ratio and thickness of a film. It is a common property obtained from a mechanical test using an instrument such as an Instron. Furthermore, stretching films are varied to produce the desired refractive index as taught by Gilbert at col. 5, lines 10-20 and col. 7, lines 1-3. Again, it has been held that experimental modification of the prior art in order to ascertain optimum operating conditions (e.g. stretch ratios, temperatures, speed of the tensile gauges, or other process variables that effect mechanical properties such as tensile strength/tear) fails to render Applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233.

5. Applicant contests that Akamatsu does not cure the deficiencies in Shetty and Gilbert. The Examiner considers this argument moot as she has not relied upon the reference.

6. In regards to the Ouderkik reference, this reference is not and has not been relied upon in any rejection.



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7. Conclusively, the Applicant has not provided any objective evidence to provide over the prior art. Once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show an unobvious difference. “[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. 102, on prima facie obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” See MPEP 2112.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus  
Examiner  
Art Unit 1774

September 6, 2003

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read "Cynthia H. Kelly", is written over the printed name and title.